

No. 11642.

IN THE

United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT

YORK CORPORATION,

Plaintiff-Appellant and Cross-Appellee,

vs.

REFRIGERATION ENGINEERING, INC.,

Defendant-Appellee and Cross-Appellant.

REPLY BRIEF OF REFRIGERATION
ENGINEERING, INC.

LYON & LYON, PAUL R. JERREN

FREDERICK S. LYON, CLARK

LEWIS E. LYON,

CHARLES G. LYON,

811 West Seventh Street, Los Angeles 14,

*Attorneys for Refrigeration Engineering, Inc., Appellee
and Cross-Appellant.*

TOPICAL INDEX AND SUMMARY OF ARGUMENT

PAGE

Summary of Argument..... 1

- 1. The McAdam patent specifically distinguishes the invention as applicable to tap water defrosting of a coil within a refrigerated chamber constantly maintained at temperatures below the freezing point of water.

This was the problem McAdam solved and the patent is addressed to this problem and to nothing more or less.

Read in the light of the patent's description the "refrigerated space" must be one that presents this problem. This is the intent of the agreement resulting from the negotiations formulative of the patent contract according to the established principles of law. This intention controls the patent's interpretation. McAdam never abandoned such an interpretation 1

- 2. The McAdam invention is not anticipated by
 - (a) The Gayley Dry Blast installation.
 - (b) The Polar Ice installation at Idianapolis.
 - (c) The Swift & Co. installation at Elmira.
 - (d) The Yamhill installation..... 1

Argument	2
The Error, in Fact and in Law, of York's Contention That the Patent Office Proceedings Preclude by Estoppel "That the Refrigerated Space of the Claims Means 'A Refriger- ated Space Always Maintained Below Freezing' ".....	2
The McAdam Patent Is Not Anticipated by the Gayley Dry Blast Installations	16
The McAdam Patent Is Not Anticipated by the Polar Ice Installation at Indianapolis.....	19
The McAdam Patent Is Not Anticipated by the Swift & Co. Installation at Elmira.....	21
The McAdam Patent Is Not Anticipated by the Yamhill In- stallation	22
Conclusion	24

INDEX TO APPENDIX

	PAGE
U. S. R. S. 4888.....	1
Patent Office Rule 71.....	1
Schriber-Schroth Opinion (311 U. S. 218-221).....	1
McAdam's Rebuttal of Examiner's Rejection [IV-1353-55].....	5
General Electric Co. v. Save Sales Co., 82 F. (2d) 100, 103, 104 (C.C.A. 6)	6

TABLE OF AUTHORITIES CITED

CASES	PAGE
Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U.S. 45, 70	15
Flowers v. Magor Car Corp., 65 F. (2d) 657-58.....	14
General Electric Co. v. Saxe Sales Co., 82 F. (2d) 100, 103, 104 (C.C.A. 6)	3, 15
General Motors Corp. v. Kesling (C.C.A. 8), 164 F. (2d) 821..	5
National Hollow B.B. Co. v. Interchangeable B.B. Co. (C.C.A. 8), 106 F. 693.....	2
O'Brien-Worthen Co. v. Stempel, 209 F. 847, 852 (C.C.A. 8)	2
Paraffine Companies, Inc. v. McEverlast, Inc., 84 F. (2d) 335, 339 (C.C.A. 9).....	20
Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211, 218, 221	10, 11, 12
Smith v. Snow, 294 U.S. 1, 16.....	11
Topliff v. Topliff, 145 U.S. 156, 171.....	9

STATUTES

California Code of Civil Procedure, §1963, subds. 5, 6.....	23
R. C. P. No. 52.....	24
U.S.R.S., §4888, 35 USCA §33.....	2, 14, 15

TEXTBOOKS

Deller's Walker on Patents, Vol. II:	
§240, p. 1204.....	2
§261, pp. 1243-44	2
§270, p. 1262.....	15
Rules of Practice of U. S. Patent Office Rule 71.....	6

No. 11642.

IN THE

United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT

YORK CORPORATION,

Plaintiff-Appellant and Cross-Appellee,

vs.

REFRIGERATION ENGINEERING, INC.,

Defendant-Appellee and Cross-Appellant.

REPLY BRIEF OF REFRIGERATION
ENGINEERING, INC.

Summary of Argument.

1. The McAdam patent specifically distinguishes the invention as applicable to tap water defrosting of a coil within a refrigerated chamber constantly maintained at temperatures below the freezing point of water.

This was the problem McAdam solved and the patent is addressed to this problem and to nothing more or less.

Read in the light of the patent's description the "refrigerated space" must be one that presents this problem. That is the intent of the agreement resulting from the negotiations formulative of the patent contract according to the established principles of law. This intention controls the patent's interpretation. McAdam never abandoned such an interpretation.

2. The McAdam invention is not anticipated by
 - a. The Gayley Dry Blast installation.
 - b. The Polar Ice installation at Indianapolis.
 - c. The Swift & Co. installation at Elmira.
 - d. The Yamhill installation.

ARGUMENT.

The Error, in Fact and in Law, of York's Contention That the Patent Office Proceedings Preclude by Estoppel "That the Refrigerated Space of the Claims Means 'A Refrigerated Space Always Maintained Below Freezing.'"

This contention has no applicability to Claim 13 (adjudged valid and infringed) or to Claims 10 and 11. The mode of operation of the combination defined in each of these claims is dependent upon the air of the refrigeration space not rising above the freezing point of water during the time required for defrosting. [IV-1432, McAdam Patent, p. 4, col. 2, Claim 10, lines 8-11, Claim 13, lines 43-45]. It could not be *above* the freezing point of water if it is to be prevented from rising above such temperature.

Letters Patent are a contract between the United States Government and the patentee (*National Hollow B.B. Co. v. Interchangeable B.B. Co.*, 106 F. 693 (C.C.A. 8); *O'Brien-Worthen Co. v. Stempel*, 209 F. 847, 852 (C.C.A. 8)).

"A patent is subject to the same general rules of construction as other contracts."

(Deller's Walker on Pats., Vol. II, §240, p. 1204, citing cases).

It is well settled that the scope of such agreement is limited by its terms as *finally* agreed upon between the inventor and the Patent Office.

The Patent Law [U.S.R.S. 4888, 35 USCA §33, cf. App. p. 1]* requires that " * * in case of a machine,

*Reference is to the accompanying Appendix.

he shall explain the *principle* thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; * * *". (Emphasis supplied.) In compliance with this statute, the McAdam patent [p. 1, lines 1-14] particularizes that the refrigerated space must be constantly maintained at temperatures below the freezing point of water. The application of this principle distinguishes it from prior inventions. To be a machine or apparatus embodying and utilizing McAdam's invention so explained, such a machine must be based upon this stated principle. To provide a machine working upon this principle was the unsolved problem in the refrigeration art.

All of the original application claims (1-14) were rejected [first Office action, IV-1348] on the patent to Kagi [IV-1471]. This Kagi patent was the only prior patent relied upon by the Examiner in rejecting these claims at any time.*

In McAdam's response to this rejection he pointed out that "* * * all of the claims call for a space which is *constantly maintained* below the freezing point of water, * * *" [IV-1353; see App. p. 5 for complete notation]. This interpretation of the claims was consistently maintained by McAdam to the grant of the patent and is consistent with his statement of the principle upon which his novel combination is grounded.

" * * it has long been settled that where references in the record were before the Patent Office and were rejected as anticipations the presumption of novelty and invention which arises from the grant of the patent is greatly strengthened. (Citing cases.)" (*General Electric Co. v. Saxe Sales Co.*, 82 F. (2d) 100, at 103 (C. C. A. 6).)

Thereafter, on his second action, the Examiner stated:

“Applicant has attempted by amendment to differentiate his claims over the prior art cited by stating that his device *continuously* maintains a freezing temperature below the freezing point of water. However, such limitation is immaterial insofar as patentability is concerned since practically all refrigeration systems continuously maintain a predetermined temperature which may be above 32° or below 32° depending upon the particular requirements placed upon the system. However, such regulation or particular degree of temperature maintained is not of patentable import.” [IV-1368].

Although the words, “the air of which is continuously maintained at a temperature below the freezing point of water” were cancelled from claims 1, 2 and 3 [IV-1371], 7 and 9 [IV-1372], because the Examiner ruled that said words constituted an immaterial limitation, adding “However, such regulation or particular degree of temperature maintained is not of patentable import”, McAdam never changed his position that the newly invented mode of operation of his invented combination was dependent upon the temperature of the air in the refrigerated space being below the freezing point of water. McAdam took issue with the Examiner’s statement that “such regulation or particular degree of temperature maintained is not of patentable import.” He supplied the affidavits of James W. Hatch, Walter F. Hancock, D’Artagnan T. Ward, William L. Holladay, Robert E. Woods, and Joseph H. Batteiger [IV-1378-1402].

After full consideration of these affidavits, the Examiner stated:

“The six affidavits submitted by applicant have been noted by the Examiner and filed in the application.

It is obvious that if the water supply in Kagi was confined in a space the temperature of which was maintained at below 32° that the pipe would freeze, but it is also obvious that to prevent such freezing the valve would be vented and the valve would be placed outside the freezing chamber. Such remedy would be obvious and would not amount to patentable import. Vented valves have long been known in the arts for just such purpose.” [IV-1408, emphasis supplied].

Thus the Examiner reversed his holding of immateriality. This reversal would have been unnecessary had the Examiner not considered that in view of McAdam’s specification the term “refrigerated space” as used in the claims then under consideration was to be interpreted so as to include the principle and mode of operation of McAdam’s combination so dependent upon said “particular degree of temperature so maintained,” *i. e.*—that the air in the space was maintained below the freezing point of water.

The McAdam application and the patent as issued made this refrigerated space as so interpreted of the very essence of the McAdam invention. (Cf. *General Motors Corp. v. Kestling*, C.C.A. 8, 164 F. (2d) 821.) It specifically points out that the novel mode of operation of the McAdam combination is dependent upon this. It states:

“My invention relates to low temperature refrigeration where a space is required to be constantly maintained at temperatures below the freezing point of water, and the invention relates more particularly to methods and devices for defrosting the coils or heat transfer surfaces used in maintaining such conditions.

Where the air which is being recirculated over these low temperature surfaces never rises above the freezing point of water periodic defrosting under main-

tained low temperature conditions has presented many problems. It is an object of this invention to provide simple and highly effective means for so defrosting.”

[IV-1429, McAdam Patent, p. 1, lines 1-14].

The Rules of the Patent Office provide:

“Rule 71. The specification and drawing must be amended and revised when required, * * * to secure correspondence between the claim, the specification and the drawing * * *”.

In allowing the patent claims, the Examiner obviously considered (as did McAdam) that McAdam’s quoted statements of the principle of his invention was “a space is required to be continuously maintained at temperatures below the freezing point of water”. At no time did the Examiner, after the cancellation of “the air of which is continuously maintained below the freezing point of water” object to this specific statement and requirement of the patent specification. Nor did the Examiner require the specification to be restricted to correspond with the claims, as it would have been necessary to do had the Examiner intended that this requirement be eliminated from the interpretation of the claims.

In the affidavits submitted by McAdam to controvert any assumption by the Examiner that the McAdam combination was not patentably inventive over the Kagi patent disclosure, the affidavit of Hancock points out that the device of the Kagi patent is “inoperative for the purposes for which the said McAdam device is intended in that water will not properly drain from the irrigator or spray head ‘k’ and will remain in the conduit leading thereto and in the ports or chambers of the valve ‘1’ so that when the temperature of the air adjacent the coil ‘a’ and surround-

ing said valve, spray head and conduits respectively, is below the freezing point of water same will freeze and solidify in position and will prevent the subsequent use of the device for the purpose of defrosting with water." [IV-1383-84].

Hancock further stated:

"I have personally operated a device invented by McAdam and have found it to be fully operative to supply water to a coil situated in a box known to me to have been at a temperature at least 25 degrees below the freezing point of water and not higher than 7 degrees Fahrenheit continuously for 12 hours prior to my operation of the device and that after having operated the device the same to my knowledge became so thoroughly drained that after another lapse of 4 hours during which the temperature within the box in which the coil and device were located never rose above 7 degrees Fahrenheit I was able to again operate and did again operate the device for defrosting of said coil and found that the second operation as well as the first operation was not interfered with by the presence of ice in its conduits, spray head or the like.

It is my opinion that the device of Kagi is useless for water defrosting under the same conditions and that after use in a freezing atmosphere it would be impossible to move the valve 'l' to open position and if such were done by thawing same the device would still be inoperative and water would not flow through the conduit so long as the temperature in the space enclosing the spray head 'k' and the attached conduit was at a temperature below the freezing point of water." [IV-1384-85].

Hatch [at IV-1379], refers to the fact that his company “* * * has been confronted with a demand for coils which could be defrosted without allowing the temperature of the freezing compartment to rise above the freezing point of water.” And at page 1380, again refers to the freezing compartment maintained below the freezing point of water.

See Holladay affidavit [IV-1391-94]; Woods affidavit [IV-1395-98]; Batteiger affidavit [IV-1399-1402].

These affidavits were presented in the McAdam application to point out the distinctive principle of the McAdam invention and the total lack thereof in the Kagi patent disclosure. The Kagi patent was the sole basis of the Examiner's rejection. These affidavits make comparisons which demonstrate that McAdam did not abandon his assertion that the novel principle of his apparatus resided in the refrigerated space being maintained at a temperature below the freezing point of water and that when provision was made for continuous drainage thereof, the spraying over the refrigerating coils of tap water at ordinary ground temperature would melt the ice and frost adherent to the coils.

The Examiner's final rejection [IV-1408] above quoted was not based upon the Examiner's assertion that the temperature of the air in the refrigerated space was immaterial. It was based upon his (subsequently abandoned and withdrawn) assertion that “It is obvious that if the water supply in Kagi was confined *in a space the temperature of which was maintained at below 32°* that the pipe would freeze, but it is also obvious that to prevent such freezing the valve would be vented and the valve would be placed outside the freezing chamber. Such remedy would

be obvious and would not amount to patentable import. Vented valves have long been known in the arts for just such purpose." (Emphasis supplied.)

Upon such final rejection McAdam appointed attorneys to represent him. An oral hearing was had; the substance thereof was engrossed in a final paper of submission of the McAdam application [IV-1414-20]. Thereupon the McAdam application was allowed [*id.* 1423].

Such an interpretation of the terms and provisions of the patent is required as will give such effect to the Patent Office proceedings to reflect the true intention of the parties. It is clear that McAdam never abandoned but continuously insisted that the patentable novelty of his combination inhered in the refrigerated space being maintained at a temperature below the freezing point of water; that with such a refrigeration of the space, his combination solved the problem of defrosting the coil by the use of ordinary tap water at normal ground temperatures.

"The object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation." (*Topliff v. Topliff*, 145 U.S. 156, 171.)

The affidavits of Hatch, Hancock, Ward, Holladay, Woods and Batteiger contain many references to the difficulties encountered "where the freezing compartment was maintained below the freezing point of water * * *" [IV-1380]. An example of the fact that Hancock, although actively engaged in the refrigeration business commercially as superintendent and chief engineer of Bedell

Eng. & Refrigeration Eng. for 12 years prior to December 1939, states that:

“During this period I had never seen, nor had I ever on good authority heard, of any attempt to defrost refrigeration coils operating in an enclosed, refrigerated, space constantly maintained considerably below the freezing temperature of water, until I witnessed the performance of a device known to me to have been invented by the above mentioned Harry H. McAdam, which device after spraying water over a frosted coil acts to then drain all conduits, spray head, drip pan and the like so completely that no water remains to freeze to clog the device.”

[IV-1383; cf. Ward, 1387; Holladay, 1391; Woods, 1395; Batteiger, 1399].

Without regard to these facts of the instant case, York's brief (p. 14) culls two extracts from the opinion in *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211 (pp. 220, 221).

York's brief places an erroneous interpretation upon the quoted pages—an interpretation which is not in accord with the facts of the case as recited by the Supreme Court. In the *Schriber-Schroth* opinion there is nothing from which it can even be inferred that the Supreme Court by that decision intended to pronounce any new rule of patent interpretation or to reverse any principle theretofore established by that court. There is inherent in this opinion no ruling that the subsequent grant of a claim broader than any rejected claim is to be limited by file wrapper estoppel. The subsequent allowance of such broader claim is cogent evidence that upon reconsideration the Examiner has adjudged the applicant entitled to a broader claim than he had theretofore considered the applicant entitled to. And

the patent is to be so construed to accord with the intention of the parties to the contract. Nor does this *Schriber-Schroth* opinion, or any decision cited therein, adjudge that the "refrigerated space" specified in a combination is not required to be of the kind and operated under the conditions specified in the specification as defining the kind of an operation upon which the newly invented combination is based.

Does appellant, in York's brief, intend to assert that in the *Schriber-Schroth* decision the Supreme Court intended to overrule its decision in *Smith v. Snow*, 294 U.S. 1, wherein, at page 16, it said:

"It is of no moment that in the course of the proceedings in the Patent Office the rejection of narrow claims was followed by the allowance of the broader Claim 1. *Westinghouse Electric & Mfg. Co. v. Condit Electrical Mfg. Co.*, 194 F. 427, 430 (C.C.A. 2d)."

In this *Smith v. Snow* opinion an argument that the rejection and cancellation of narrower claims than Claim 1 constituted a surrender of scope and interpretation, a restriction of the broader allowed and granted broad Claim 1, was thus repudiated by the Supreme Court. We submit there is nothing in the *Schriber-Schroth* opinion evidencing any intention to reverse or modify or restrict this *Smith v. Snow* statement of the law. It is true that at the trial of this *Smith v. Snow* case there was no attempt by the patentee to broaden the scope of Claim 1 by dropping from it an element which he was compelled to add in order to secure the allowance of that claim, nor in this case *sub judice* is there any such attempted broadening of any of the McAdam patent claims. At page

221 of 311 U.S., in the *Schriber-Schroth* opinion the following language appears:

“True, the rule is most frequently invoked when the original and cancelled claim is broader than that allowed, but the rule and the reason for it are the same if the cancelled or rejected claim be narrower.”

What the court in the last clause of the above quotation refers to is that it does not make any difference in law whether the original and cancelled claim was a broad claim or a narrower claim,—*not* that the cancellation of a narrow claim can estop the patentee from a broad interpretation of a granted broad claim. This is only a repetition of the familiar rule stated in *Smith v. Snow*, 294 U.S. at p. 15, that:

“It is a familiar rule that a patentee cannot broaden his claim by dropping from it an element which he was compelled to add in order to secure his patent. *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 443. 71 L. Ed. 335, 342, 47 S. Ct. 136; *Smith v. Magic City Kennel Club*, 282 U.S. 784, 789, 790, 75 L. Ed. 707, 712, 51 S. Ct. 291.”

It is thus seen that York's second quotation from the *Schriber-Schroth* opinion merely states that the doctrine of file wrapper estoppel applies equally to a broad claim or to a narrow claim; that the rule is “* * * that a patentee cannot broaden his claim by dropping from it an element which he was compelled to add in order to secure his patent.” (*Smith v. Snow*, 294 U.S. 1, 14, 15.) That the *Schriber-Schroth* opinion does not modify or

extend this rule is further made clear from a consideration of the discussed facts of such case [cf. App. p. 1].

“The claims must be read in the light of the disclosure of the specification, not to restrict the invention to the precise structure disclosed, but to grasp the invention in order properly to measure the range of equivalents. (*Flowers v. Magor Car Corporation*, 65 F. (2d) 657, C.C.A. 3 (1933).) While the description may limit a claim, which must always be read in the light of the prior art (see *Pelton v. American, etc., Co.*, 239 Fed. 320, 321, C.C.A. 2 (1916), and can never expand it (see *Fowler v. McCrum, etc., Co.*, 215 Fed. 905, 909, C.C.A. 2 (1914), a patent (*i. e.*, a claim) can never be given a construction broader than its terms in order to cover something which might have been claimed but was not. (*Universal, etc., Co. v. Sonn*, 154 Fed. 665, C.C.A. 2 (1907).) *But the claims whenever possible are to be constructed so as to cover the real invention as found in the specification and drawings, and this is particularly so in the case of a meritorious invention.* (*Mossberg v. Nutter*, 135 Fed. 95, 99, C.C.A. 1 (1905); *Elec. Candy Mach. Co. v. Morris*, 156 Fed. 972, 973-74, C.C., E.D. Mo. (1905); *Malignani v. Jasper Marsh, etc., Co.*, 180 Fed. 442, 454, C.C. Mass. (1910); *Victory Belt Co. v. Marshall Field & Co.*, 300 Fed. 67, 71, C.C.A. 7 (1924); *Cadwell v. Firestone Tire & Rubber Co.*, 13 F. (2d) 483, D.C. E.D. N. Y. (1926); *Sun Ray Gas Corp. v. Bellores-Claude Neon Co.*, 49 F. (2d) 886, 888, C.C.A. 6 (1931).)”

(Deller's Walker on Patents, Vol. II, §261, pp. 1243-44. Emphasis supplied.)

The specification is for the purpose of full explanation of the real invention and it is “in the Light of the Description” that the claims must be read to correctly grasp the invention. (*Flowers v. Magor Car Corporation*, 65 F. (2d) 657-58.)

It is the constantly-maintained below-freezing temperature of the air in the refrigerated space which presents the problem of defrosting by tap water. This requires continuous draining of the melted ice and frost during the defrosting operation. This is stressed in the McAdam patent. *McAdam never abandoned* his assertion that this was the combination which constituted his invention*—not something else. Whatever was the reason for the Examiner’s original holding that the maintenance of such a constant freezing temperature was immaterial, the fact remains that the McAdam patent as granted specifically and emphatically complied with the requirements of R.S.U.S. 4888, not only in pointing out the principle of his invention, but in differentiating his combination from prior defrosting operations as designed for defrosting where the refrigeration coil is located in a chamber constantly maintained at or below 32° F.; that it was to such an operation that his invention was directed. He did not claim he invented or discovered maintaining such a temperature therein, but claimed a combination of elements such as when used therein would render tap water defrosting practical and efficient. The operation to which

*Cf. App. p. 5, “McAdam’s Rebuttal of Examiner’s Rejection.”

he refers is one wherein the refrigerated space is constantly maintained at temperatures below the freezing point of water [cf. McAdam patent, p. 1, col. 1, line 16 to line 29, col. 2, p. 2; IV-1429].

York contends (p. 15) that to interpret the "refrigerated space" in accordance with the McAdam patent's particularization of the principle of the McAdam combination "is also untenable because in effect it turns apparatus claims into method claims." Even if this were true, this would not render the claims invalid. R.S.U.S. 4888 requires no distinction between claims for a method and claims for a machine:

"Claims which are functional in form; that is to say, claims which literally purport to cover a result rather than a process or a thing, are properly construed to cover only the process or the thing which produces that result, for otherwise such claims would be void. (Citing cases.) And a claim which literally purports to cover a process performed by machinery may under certain circumstances be properly construed to cover the machinery itself, and not any process performed thereby. (*Smith & Egge Mfg. Co. v. Bridgeport Chain Co.*, 46 Fed. 393, 395, C.C., Conn.)"

(Deller's Walker on Pats., Vol. II, §270, p. 1262.)

(cf. the claims in *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, and reference thereto at page 70 and in *General Electric Co. v. Save Sales Co.*, 82 F. 2d 100, CCA 6, App. p. 6.)

The McAdam Patent Is Not Anticipated by the Gayley Dry Blast Installations.

In our opening brief, pages 28-33, we have pointed out that the huge structures employed at various steel plants for drying the air prior to use in blast furnaces, and known as Gayley dry blast installations, do not anticipate the McAdam patent for the reasons: (1) that they were not self-draining; (2) the refrigeration units were not located in a space constantly maintained below the freezing point of water and (3) that the defrosting system involved the use of doors and vanes to isolate the refrigerating unit during the defrosting operation, the time interval being sufficient to insure that an elevated temperature was reached.

York Corporation takes issue with the assertion that, as found by the District Court [FF. 21, I-17], these units were not self-draining. Opposite page 18 of York's opening brief is a photographic reproduction of Plaintiff's Exhibit 1. Referring to this exhibit, it will be noted that a "water spray 2" pipe" at the upper part of the figure is colored red. Proceeding to the left there is an inclined pipe communicating with a round figure labeled "6" water header." Leading from this 6" water header is a yellow pipe. The Court will note that the bottom of this yellow-colored pipe is considerably above the bottom of the 6" water header, thus effectively assuring that the 6" water header could not possibly be drained. This in itself completely substantiates the finding of the Court and refutes York's position.

On page 26 of its brief York makes the erroneous statement that "Finding 21 relates only to Pittsburgh and Chicago." The apparent basis for this assertion is that

Finding 21 refers to depositions taken in Pittsburgh and Chicago. York's counsel failed to note that the depositions concerning Mayville were also taken at Chicago [II-504].

With respect to the South Chicago Gayley dry blast installation (particularly with respect to Exhibit 31), York argues (p. 27) that the water main passed through the top of each of the seven separate refrigerant chambers so that if No. 7 were being defrosted, the water would have to pass through the preceding six operating chambers. This is clearly contrary to fact. The water main was in a hallway outside of these chambers. Tominac testified that there was such a hallway running along the edge of this building, and that the valves on this water main were located in the hallway [II-513-514]. The valves, marked A in Exhibit 31, are between the water main and the coils. The drawing, Exhibit 31, is incorrect in not showing these valves in the hallway [II-513, 522]. This being true and the water main not passing through the successive compartments, York's argument that the problem faced by McAdams existed in this Gayley dry blast installation is clearly without foundation in fact.

The Gayley dry blast installations were not concerned with the problem of defrosting within a space constantly maintained below freezing. York's witnesses Tominac [II-532] and Mueller [II-615] establish that the brine used for refrigeration when it was pumped out of the coils was above freezing. If their refrigerating medium itself is above freezing, the space within which the refrigeration medium was used could not be below freezing.

In its statements of points to be relied upon on appeal [III-1109] York Corporation, of the patents

pleaded in the Answer, asserted only the U. S. patent Wenzl 2,097,851 and the French patent to Jensen & Roser No. 800,640. Despite this, in its brief plaintiff now relies upon the patent to Brassert No. 958,471 and the patent to Gayley No. 1,002,576. While we do not believe that these patents are properly before this Court, they can be disposed of here as they relate to these Gayley dry blast installations. Neither of these patents shows any system of draining the supply conduits and therefore clearly neither of them anticipates the McAdam combination. Neither of these patents makes any statement as to the temperatures maintained in the refrigerant chambers, especially during defrosting.

The patent to Brassert in fact substantiates our contention with respect to the temperature in the refrigerant chamber. On page 1, col. 2, lines 64-65 [IV-1259] the patent states:

“After a certain period of operation, snow or ice will collect *on the upper coils.*” (Emphasis ours.)

It is thus recognized that only the upper portion of the chamber is cold enough to produce frost. It is a well-known physical fact that frost will be produced whenever the temperature is reduced below the dew point; it is not necessary to reduce the temperature of the atmosphere to a freezing temperature in order to accomplish this. Thus the lower portion of the coils in these Gayley dry blast systems were not even below the dew point, let alone constantly maintained below the freezing point of water.

The McAdam Patent Is Not Anticipated by the Polar Ice Installation at Indianapolis.

In our opening brief we have pointed out, pages 34-38, that the purported installation at Polar Ice Co. was not proven to have ever been operated below freezing and was not self-draining but on the contrary was operated above freezing and used to store soft drinks, milk and the like. The unit was not capable of being operated below freezing as it was not self-draining and water stuck in the line [II-495]. The burden of proof rests upon York to conclusively establish the contrary.

Contrary to York's assertion (p. 33) that "There is nothing in the record to contradict" the testimony culled from the record to support its contentions, our opening brief, page 36, points out that the pipes as shown in Exhibit 18 are inclined the wrong way to be self-draining. York answers that they have sagged (York's brief, p. 35). However, its own witnesses have precluded any such contention. Barton and Martin both testified that there were no changes of any kind in the unit as installed and as shown in the photograph [II-418, 502].

York argues that this unit was guaranteed to hold a temperature of 30° F., but admits that this was not met as "first installed" (York's brief, p. 32).

The evidence of the witness Simons is unequivocal to the fact that from 1936, when he leased the premises, the temperature was 33° F. (Our opening brief, p. 35), and there was no change in the purpose for which the premises were used, which obviously did not require a below-freezing temperature (*id.* p. 35). This together with the "wet rot" of the walls (*id.* p. 36) is strong evidence in the record to contradict York's contentions.

It must be borne in mind that the burden rests upon York to establish "beyond a reasonable doubt" not only

the construction of this device but also all facts with reference to its manner of use. This burden does not rest upon Refrigeration, Inc. *Paraffine Companies, Inc. v. McEverlast, Inc.*, 84 F. 2d 335, 339, C.C.A. 9.

York also attacks the Finding No. 31 [I-19] that this unit was abandoned and discarded. We have shown that the attempt to patent this unit was abandoned (Our brief, p. 38); that an abandoned patent application is a nullity so far as anticipating a patented invention is concerned. There is not even a contention by York and no evidence in the record that from 1936 on this unit was a below-freezing installation. If a below-freezing operation was originally contemplated, it was discarded and abandoned. Clearly, then, as early as 1936 any suggestion of operating this unit within the conditions of the McAdam invention, *i. e.*, below freezing, was fully abandoned and discarded.

The most material proof in the letter of Goldsmith to Galt is his statement [IV-1144]

“* * * The Frick people, who have seen this device and have been engaged in the refrigerating business for almost a half a century, have intimated that *it is something radically new* and are surprised their own engineers have never seen it performed before or ever thought of it before, because it is so simple, but it does solve the problem first outlined,—prevention of ice blocks freezing together.” [Emphasis ours, IV-1144.]

Whatever the referred to device was, the Frick people (like the refrigeration experts on the advent of the McAdam invention), recognized it as “something radically new.” [cf. Finding 9, I-15, and our opening brief, pp. 23-4.]

The McAdam Patent Is Not Anticipated by the Swift & Co. Installation at Elmira.

We have pointed out in our opening brief that the pickle room and sausage room at Elmira were not below-freezing installations, were not self-draining and that Swift & Co. had a below-freezing room at Elmira using a totally different method of defrosting.

York argues that these units occasionally went below freezing over a week-end but there is absolutely no evidence that anyone ever attempted to defrost under such conditions, therefore there was no attempt "to introduce water into a space which was below the freezing point of water" as contended by York at pages 37-8 of its brief.

With respect to the inclination of the pipes, York contends that the reason they are not now pitched so as to be self-draining is because they have "sagged" (York's brief, p. 39). Such a contention is also made with respect to the Polar Ice installation. We believe that the present, observable condition is the best evidence of how these pipes were installed but even if it is true that the pipes have sagged, it conclusively proves that these installations do not involve the McAdam invention. McAdam's invention requires the supply and drain lines to be so pitched as to be self-draining. It would be inoperative without it, and it is not anticipated by a device which is apparently indifferent to the direction of pitch of the pipes.

On p. 39 of its brief, York states that the third room, the below-freezing room at Elmira, had bare pipe coils arranged about the walls of the room. This is a mere assertion by counsel for York *totally unsupported by anything in the record.*

The McAdam Patent Is Not Anticipated by the Yamhill Installation.

We have pointed out in our opening brief that the evidence with respect to this alleged Yamhill prior use insofar as it relates to the attempt to use water defrosting is hopelessly conflicting and confused. York in its brief relies principally on the witness Hulse's testimony (given in open court), even going so far as to print the drawing, Ex. Y-28, made by Hulse in 1946,—nine years since he had seen the installation (York's brief, p. 40).

This witness was specifically found to be unworthy of belief [Finding 47, I-22; cf. our opening brief, p. 46]. His drawing, Ex. Y-28, is contradicted by York's witness Trullinger who unqualifiedly stated that there was a door on the diffuser outlet which he closed during defrosting to keep the cold out (our opening brief, p. 46).

On p. 41 of its brief, York states what it claims was the method of operation of this installation but fails to note that there is also a conflict in the testimony here. York fails to mention the closing off of the diffuser from the locker room prior to defrosting to isolate it and keep the cold out (our opening brief, pp. 45-6). York also states that the water was shut off "when it had been observed that all of the frost had been removed," but note the testimony of Dahl that even when it appeared that the coil was free of ice, large blocks of heavy glazed ice would remain on the lower side of the coil [III-1077].

York argues in its brief, pp. 41-2 and 47-8, that this installation was perfectly satisfactory, ignoring the admissions of its witness Eustice that it was unsatisfactory [III-845, 850]; the statement of its witness Postlewaite that they couldn't make it work [III-894] and the testimony of Dahl referred to above.

On the point of the temperature of the isolated chamber containing the diffuser, York again relies (York's opening

brief, pp. 43-4) on the “not worthy of belief” testimony of Hulse and also depends on his testimony as to the public nature of the installation (*id.* 46). The turkey referred to (*id.* p. 42) clearly proves nothing. Does York claim that turkey was still frozen on its one-month trip from Yamhill to Amity [III-838]?

On p. 45 of its brief, York states that this unit was in use from November, 1936, to December, 1938, or January, 1939. We have pointed out in our opening brief that the evidence does not establish when the walls were built around the diffuser to isolate it (our opening brief, p. 44). Prior to the building of these walls the unit was admittedly unsatisfactory, as they couldn’t defrost it [III-782-3]. Thus York has not established a beginning date for this alleged prior use. Neither has the date been established when it was abandoned. York’s brief states that it was December, 1938, or January, 1939, but its witness Eustice states:

“Q. 113. When was that done? A. Well, I can’t recall, but it was in 1937 or the first part of 1938.”
[III-845.]

As pointed out in our opening brief, p. 44, the records to prove when this was done were available to York in the possession of its witness Trullinger, but were not produced. In such a case it is presumed that these records would be adverse to York’s contentions. California Code of Civil Procedure, Sec. 1963, subds. 5, 6.

All of the matters urged by York with respect to this alleged Yamhill prior use have been dealt with in our opening brief wherein it is pointed out that the evidence fully supports the detailed findings of the trial court. Clearly, York’s assertion that there is no evidence to support the findings is contrary to the record. These

findings are not “clearly erroneous” within the meaning of R.C.P. No. 52. Moreover, York’s heavy burden of proving a prior use “beyond a reasonable doubt” is not sustained by such a confused, contradictory and incomplete record.

York’s witness Postlewaite remained in the refrigerating business long after this alleged Yamhill installation. He testified:

“I knew that defrosting was a problem, a very serious problem” [III-898].

This refutes York’s claim in its brief, p. 59, that there was no problem for McAdam to solve.

Conclusion.

It is respectfully submitted that:

(1) That upon York’s appeal the judgment should be affirmed;

(2) Upon Refrigeration Engineering’s cross-appeal the judgment of invalidity of Claims 1-12, inclusive, and Claim 14 should be reversed and the District Court directed to enter judgment adjudging these claims valid and adjudging Claims 1, 2, 5, 6, 7, 8, 12 and 13 infringed by York;

(3) That the injunction of the judgment be extended to cover and embrace Claims 1, 2, 5, 6, 7, 8, 12 and 13 and the recovery of damages under each of these infringed claims.

Respectfully submitted,

LYON & LYON,
FREDERICK S. LYON,
LEWIS E. LYON,
CHARLES G. LYON,

*Attorneys for Refrigeration Engineering, Inc., Appellee
and Cross-Appellant.*

APPENDIX.

U. S. R. S. 4888:

“Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. * * *”

Patent Office Rule 71:

“The specification and drawing must be amended and revised when required, to correct inaccuracies of description or unnecessary prolixity, and to secure correspondence between the claim, the specification, and the drawing. But no change in the drawing may be made except by written permission of the office and after a photographic copy of the drawing as originally presented has been filed.”

Schriber-Schroth Opinion (311 U. S. 218-221):

“The Jardine patent was described as of the slipper type of piston although not limited to that type, the skirt consisting of two separated parts circumferentially separated from the piston head, supported by the webs which con-

nect the skirt or slippers with the piston head and support wrist pin bosses from which the skirt is retracted or cut away. The claims of the Jardine application as filed or later amended and ultimately allowed made no reference to the webs as flexible, yielding, or resilient, which the court of appeals found, when cooperating with other structural elements, to be a distinguishing feature of Jardine's invention. Claim 8 of the Jardine patent, which is typical of the three which the court below sustained, reads:

“ ‘In a piston for an internal combustion engine, the combination of a head having a cylindrical ring flange, oppositely disclosed webs integral with the flange and carrying diametrically opposite piston pin bosses, a skirt integral with said webs and cut away to expose the sides of said webs and separated from the ring flange by circumferential slits and provided with a longitudinal slit disposed between the ends of the webs.’ ”

“Claims 5 and 6 refer to the ‘skirt portion cut away from the head to expose the bosses.’ ”

“While the application was pending Jardine amended his claims so as to supply this omission. In various forms he claimed the piston head, skirt and web combination with piston head separated at its flange or periphery from the skirt, the skirt slotted or separated into parts and connected with the head by the webs variously described as ‘yielding ribs,’ ‘resilient arms,’ ‘skirt carriers . . . susceptible of being slightly flexed radially,’ or as ‘joining means being resiliently yieldable,’ or as ‘means for yieldingly connecting the said skirt section with said head.’ These claims, as a result of being thrown into interference with Hartog, No. 1,842,022, applied for February 16, 1920, allowed January 19, 1932, and in some instances with Gulick and with Long, No. 1,872,772, applied for

March 7, 1919, allowed August 23, 1932, were rejected by the patent office. Jardine then withdrew all of these amendments. Of these amended and cancelled claims, Claim 18 (19 E) is typical. It reads as follows:

“ ‘In a piston of the class described, a cuplike head comprising a pressure receiving end and a wall portion, a skirt, circumferentially disconnected from the wall portion of the head and divided from end to end, and skirt carriers connecting said skirt to the pressure receiving end, said skirt carriers being disconnected from the wall portion of the head and susceptible of being slightly flexed radially.’

“Upon comparison of the withdrawn claim with Claim 8 of the patent as allowed it will be observed that both are combination claims for a piston having a head, a divided or slotted skirt disconnected from the wall portion of the head and connected with the head by ribs, webs or skirt carriers. The only material difference in view of what has been said to be the invention is the statement in the withdrawn claims that the skirt carriers (webs) are ‘susceptible of being slightly flexed radially’ or the like. Whatever would have been the proper construction of the claims as allowed, read in the light of the specifications alone, there being no amendments, the question now presented is whether in view of the amendments and their withdrawal the patent can rightly be construed as including the flexible webs in the claim allowed.

“In addition to the fact of the cancellation of the only claims specifying flexing webs or their equivalents as a feature of the invention, it is to be noted that at no time during the prosecution of the Jardine application did he urge that he was the inventor of a piston having flexible

webs. Before the interferences and in distinguishing his invention from the Ricardo piston, Jardine urged as his only advance over Ricardo the addition of the slotted skirt which 'changes the structure and the resistance to a disposal of the forces within and without the piston when the piston is in use,' although in this litigation it is contended that the Ricardo patent did not disclose flexing webs. In submitting the final amendment cancelling the flexible web claims in interference and presenting the claims 8 and 11 of the Jardine patent held valid by the court below, there is no mention of flexing webs, the features stressed being in the case of Claim 8 that the webs are integral with the ring flange and in the case of Claim 11 that the webs are integral with the flange and extend 'convergently inwardly' therefrom.

"It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent. (Citing cases.) The patentee may not, by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had without the amendments, the cancellation of which amounts to a disclaimer. (Citing cases.) The injurious consequences to the public and to inventors and patent applicants if patentees were thus permitted to revive cancelled or rejected claims and restore them to their patents are manifest. See *Leggett v. Avery*, 101 U. S. 256, 259, 25 L. ed. 865, 866.

"True, the rule is most frequently invoked when the original and cancelled claim is broader than that allowed, but the rule and the reason for it are the same if the cancelled or rejected claim be narrower. (Citing cases.)"

McAdam's Rebuttal of Examiner's Rejection [IV-1353-55]:

"It is submitted that all of the claims call for a space which is *constantly maintained* below the freezing point of water, even during the defrosting period, and that this invention is unique in providing that such a space can be maintained BELOW the freezing point of water at all times while the coil which does this work is being momentarily raised above that temperature and is completely defrosted by a medium which would freeze instantly it left the confines of the coil and which would remain frozen, and which water would freeze in any undrained conduit such as shown by Kagi or the other references.

Applicant is engineer for Refrigeration Engineering Incorporated, of Los Angeles, California, for whom this invention was developed. This invention was developed as a result of repeated demands by the trade for a simple and efficient defrosting method for low temperature boxes and freezing rooms where products MUST BE CONSTANTLY maintained below freezing and where the air of the compartment must never rise above freezing, and where any water allowed to remain for more than a few seconds will congeal and remain frozen, and where any form of drip will continually build up as ice on the floor or walls, and where the device of Kagi or the other devices of record are totally inoperative with water.

This invention has attained immediate commercial success and engineers and others experienced in low temperature refrigeration concede that its success is due to the novel combination of low-specific-heat conduits, immediate automatic self-draining of the water supply means, and to the combination of a fan and coil so co-ordinated that air flow is substantially discontinued when the fan is dis-

continued and the warming effect of the water is thereby confined to the coil surfaces.

In the device of Kagi air would continue to flow by the usual method over the coils during defrosting just as it does when no defrosting is carried out, and this air would be so greatly humidified and warmed as to be highly impractical by heating the air of the room and by redepositing the resultant vapors on the stored products either as dew or frost. Extremely low dew points exist in rooms maintained constantly below freezing point and liberation of moisture laden air is even worse than liberation of free water.

In Kagi as in all other devices cited, exposed conduits, and undrained spaces are provided in which residual water would freeze.

It is submitted that practically every person devoid of technical training is aware of the fact that a water pipe, such as the usual domestic water system pipe, cannot be thawed out by ground water bearing against the plug of ice. The conduits of applicant, once containing a dam of ice would render the entire system inoperative and yet it can be shown that all of the many installations made by applicant and his associates remain constantly operative over indefinite periods where the temperature of the box or compartment never rises above Zero degrees Farenheit (32 degrees below the freezing point of water)."

General Electric Co. v. Saxe Sales Co., 82 F. (2d) 100 103, 104 (C. C. A. 6):

"The claim of estoppel made by the defendants and based upon the Patent Office history of the Pipkin patent, though persuasive below, is somewhat difficult to comprehend. It is true that a number of process claims were

rejected in the Patent Office over Wood, but Wood was cited as anticipating all of the claims of the patent. The inventor conceiving himself sufficiently protected in his invention by the claims allowed, thereafter and not until then abandoned others. The appellant, his assignee, seeks to recover no lost ground. The court thought that 'the Patent Office history of the Pipkin patent so far impairs its patentability over Wood as to give adequate force to the challenge of validity and to overcome the weight of the presumption of validity of the patent.' The very converse of this proposition is the law, for it has long been settled that where references in the record were before the Patent Office and were rejected as anticipations the presumption of novelty and invention which arises from the grant of the patent is greatly strengthened. *Gairing Tool Co. v. Eclipse Interchangeable Counterbore Co.*, 48 F. (2d) 73, 75 (C. C. A. 6); *Gordon Form Lathe Co. v. Walcott Machine Co.*, 32 F. (2d) 55 (C. C. A. 6); *Hildreth v. Mastoras*, 257 U. S. 27, 32, 42 S. Ct. 20, 66 L. Ed. 112. It must be noted that there is here no question of extent or scope of the claims. They are very precisely defined; in fact too precisely defined in the opinion of the court below. The principle that 'where an applicant for a patent is compelled by a rejection of his application to narrow his claims, he cannot after the issue of the patent broaden them,' as set forth in *Smith v. Magic City Kennel Club*, 282 U. S. 784, 51 S. Ct. 291, 293, 75 L. Ed. 707, or as it was somewhat differently expressed by us in *D'Arcy Spring Co. v. Marshall Ventilated Mattress Co.*, 259 F. 236, 240, cannot be here applied, because the plaintiff seeks no broader interpretation of its patent claims than their language clearly imports. There was no estoppel."

